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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,751	10/06/2003	Andrea Pahmeier	2923-570	6589

6449 7590 12/29/2005

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EXAMINER

FUBARA, BLESSING M

ART UNIT PAPER NUMBER

1618

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/678,751	PAHMEIER ET AL.	
	Examiner	Art Unit	
	Blessing M. Fubara	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-62, 77-84, 89 and 90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-62, 77-84, 89 and 90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of amendment and remarks filed 09/16/2005. Claims 51-62, 77-84, 89 and 90 are pending.

Claim Rejections - 35 USC § 102

1. Claims 51-55 remain rejected under 35 U.S.C. 102(b) as being anticipated by Thompson (US 5,531,735).

Applicants argue that the hydroxyl carboxylic acid is used to prepare the porous matrix in the invention while in the prior art Thompson, the hydroxy carboxylic acid acts to initiate decomposition of the matrix polymer when contacted therewith and that in Thompson, the matrix polymers are “either porous materials or relatively non-porous materials,” which shows clear difference between the Thompson art and the claimed invention.

2. Applicants' arguments filed 09/16/05 have been fully considered but they are not persuasive.

Claim 51 is a composition claim that is produced by ... and product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Thus as acknowledged by applicants, the prior art discloses the presence of an acid in the composition. Regarding the porous nature or non-porous nature of the

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polymer matrix, it is noted that “relatively non-porous” is non-porous and language of the prior art is “either”/“or.” Therefore, the claims read on Thompson.

3. Claims 77-93 remain rejected under 35 U.S.C. 102(b) as being anticipated by Li (US 6,090,996).

Applicants argue that Li does not describe chitosan matrix and that in the claims, chitosan is not present in minor amounts.

4. Applicants' arguments filed 09/16/05 have been fully considered but they are not persuasive.

The matrix of Li contains chitosan. The claims do not recite any amount of chitosan in the matrix. It is respectfully noted that the chitosan matrix comprises chitosan and an acid.

Claim Rejections - 35 USC § 103

5. Claims 51-62, 77-84, 89 and 90 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bakker et al. (US 5,508,036).

Applicants argue that the first and second layers in Li do not contain chitosan and that Li mentions chitosan as an adhesive material that is capable of forming an adherence layer; that Bakker does not provide indication that application and non-application, “respectively, of freeze-drying may determine whether a porous or non-porous material is obtained” and that one of ordinary skill in the art may not have had the motivation to prepare chitosan matrices. Applicants thus conclude that Bakker does not render obvious the claims.

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6. Applicants' arguments filed 09/16/05 have been fully considered but they are not persuasive.

Regarding the presence of chitosan in the matrix of Bakker, it is respectfully noted that the second layer of Bakker contains or is made from one or adhesives such as chitosan (column 12, line 49) and further, Bakker specifically clearly discloses that "in one embodiment, the first and second layers are formed from a polymer" and there is thus the suggestion that both the first and second layers may be formed from the same polymer. The claims are directed to compositions. The layers of Bakker are porous and non-porous and how the porosity is generated provides no patentable distinction of the claimed porous structure/material over the disclosed porous material of the prior art. Bakker renders the claims obvious.

No claim is allowed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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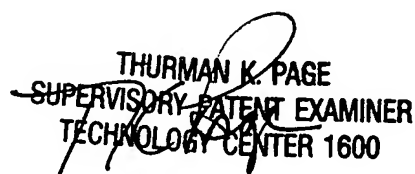
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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